

REMARKS

This is in response to the Office Action mailed June 25, 2001. Applicant thanks Examiner Tran and Supervisory Examiner Seidleck for their time during the telephone interview of September 19, 2002.

Claims 10-13, 19 and 22-23 were rejected under 35 U.S.C. §112(1). In regard to claims 10-13, 19 and 23, this rejection is now moot because claim 10 has been amended to recite “a hydrophilic surface on the container.”

Claims 10-13, 19 and 22-23 were rejected under 35 U.S.C. §112(2). Please note that this rejection is now moot due to the amendment of the claims. The claims no longer contain the word “substantially;” however, the word “substantially” was deleted for other reasons and Applicant does not agree with the rejection.

Claims 10-13 and 22-23 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,235,358 to Goto. Claim 10 has been amended to state that the titanium dioxide coating attracts “atmospheric water molecules to produce a hydrophilic surface on the container for facilitating cleaning the container.” Support for this amendment is found on page 4, line 16 of the specification.

The coating in Goto does not consist essentially of titanium dioxide so as to attract “atmospheric water molecules to produce a hydrophilic surface on the container for facilitating cleaning the container.” In Goto, a coating layer on an outside surface of a container is comprised of an ultraviolet curable epoxy resin, a photo-cationic-curing catalyst, a sensitizer and a pigment comprising titanium dioxide. The titanium dioxide is used as a pigment to add coloring to the coating, see col. 8, lines 37-39.

According to MPEP 2112.01, Applicant can present evidence to overcome a 35 U.S.C. §102 rejection to show “that the prior art products do not necessarily possess characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433. See also *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).”

As stated by Professor Phillip R. Watson, Professor of Chemistry at Oregon State University, in the attached Declaration, “the coating disclosed in Goto would not provide titanium dioxide molecules in a form that makes them available to form a hydrophilic surface on a container to facilitate cleaning the container.” (Emphasis added) Accordingly, Goto teaches against the claimed invention.

The above arguments also apply to claim 19.

In response to the statement on page 5 of the Office Action that “it has been well settled that limitations on the properties of the material worked upon or functional limitations have been held to have insignificant patentable weight in an apparatus claim,” numerous court decisions have held that functional limitations can add patentable weight to a claim. For example, in *In re Hallman*, 655 F.2d 212, 210 USPQ 609 (CCPA 1981) the applicant claimed a structure for producing images in terms of structural and functional language. The court held that:

It is well settled that there is nothing intrinsically wrong in defining something by what it does rather than by what it is....Product claims may be drafted to include process steps to wholly or partially define the claimed product. *To the extent that the process limitations distinguish the products over the prior art, they must be given the same consideration as traditional product characteristics.* (citations omitted) (emphasis added).

In Applicant’s case, Goto does not meet the claim language because Goto’s coating is not capable of attracting atmospheric water molecules to produce a hydrophilic surface on the container.

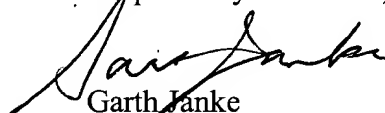
Please note that claims 22 and 24 were cancelled solely to expedite prosecution and not for reasons of patentability. Applicant does not agree that these claims introduce new matter.

Restriction Requirement

Applicant respectfully traverses the restriction requirement for the reasons given in the previous Response. However, if claims 10-13, 19 and 23 are allowed, Applicant requests that the Examiner complete an Examiner's Amendment to cancel method claims 1-9, 14-18 and 25 in order to expedite prosecution.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Garth Janke', is written over the printed name.

Garth Janke

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In the Claims:

Claims 22 and 24 have been cancelled.

Claims 1, 10, 15, 23 and 25 have been amended as follows:

1 (thrice amended). A method for reducing particle contamination inside a plastic container, comprising coating selected portions of the container with a coating that consists essentially of titanium dioxide ~~such that the titanium dioxide is not substantially prevented from attracting~~ so as to attract atmospheric water molecules to produce a hydrophilic surface on the container for ~~loosening particle contamination, for facilitating cleaning the container to prevent contamination of the article when the article is stored in the container.~~

10 (twice amended). An apparatus for reducing particle contamination of an article, comprising a plastic container adapted for holding the article, and a coating on selected portions of said container, said coating consisting essentially of titanium dioxide so as to attract ~~such that the titanium dioxide is not substantially prevented from attracting~~ atmospheric water molecules to produce a hydrophilic surface on the container for ~~loosening particle contamination, for facilitating cleaning the container to prevent contamination of the article when the article is stored in the container.~~

15 (thrice amended). A method for storing semiconductor wafers, comprising providing a plastic container, providing a coating on said container consisting essentially of titanium dioxide such that the titanium dioxide is ~~not substantially prevented from attracting~~ attracts atmospheric water vapor to produce a hydrophillic surface on the container ~~for loosening particle contamination~~, and using said container to hold the semiconductor wafers.

23. (once Amended) The apparatus of claim 10 ~~22~~, wherein said coating comprises a gel.

25. (once Amended) The method of claim 15 ~~24~~, further comprising providing said coating in the form of a gel.